

REMARKS

This amendment is submitted in response to the Office Action dated December 14, 2005. No new matter has been added, and the amendments place the claims in better condition for allowance. Applicant respectfully requests entry of the amendments to the claims. The discussion/arguments provided below reference the claims in their amended form.

TELEPHONE DISCUSSION

Applicant appreciates the courtesies extended by the Examiner with respect to the rejection for double patenting during the telephone call on March 1.

IN THE SPECIFICATION

In the present Office Action, the first paragraph on page 1 of the specification (paragraph [0001]) is objected to because the serial number and filing date of co-related application are missing. Accordingly, Applicant has reviewed the relevant paragraph and provided corrections thereto.

CLAIMS OBJECTIONS

In the present Office Action, Claims 1 and 20 are objected to for use of the phrase 'computer-usable medium' in the preamble. Accordingly, Applicant has amended Claims 1 and 20 to remove the language objected to by the Examiner and overcome the claim objections.

DOUBLE PATENTING

At paragraph 3 of the present Office Action, Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Serial No 10/670,547. Applicant submits herewith a terminal disclaimer in compliance with 37 CFR 1.321(b) to overcome the double patenting rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In the present Office Action, Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,263,303 to Yu, *et al.* (*Yu*) in view of U.S. Patent No. 5,146,460 to Ackerman, *et al.* (*Ackerman*).

(A) The proposed combination does not teach or suggest the recited elements of Applicant's claims.

With respect to exemplary Claim 1, to dependent claims 2-19, and to similar claim 20, Applicant respectfully submits that the Examiner's proposed combination of *Yu* and *Ackerman* does not render obvious Applicant's invention because the proposed combination does not teach or suggest the claimed features of Applicant's invention for which it is cited.

First, with respect to exemplary Claim 1, Applicant respectfully submits that the combination of *Yu* and *Ackerman* does not teach or suggest "providing a software representation of a plurality of hardware components within said simulated direct access storage device", as recited in Applicant's exemplary Claim 1. The Examiner correctly observes at paragraph 8 of the present Office Action that *Yu* does not teach or suggest applicability to a hard disk. The Examiner alleges that this step is taught in *Ackerman* at Column 7, line 36-47, which discloses:

In preferred embodiments of the present invention, test case and resultant state generator 50 may in fact comprise separate processor means. However, in preferred embodiments of the present invention software simulation means 66, comparison means 62 (usually part of generator 50), control means 68 and communication and storage means 64 are all present within host processor 60. Furthermore, these functions are preferably implemented by means of software programs residing in one or more memory units (including direct access storage devices (DASD)) accessible by host processor 60 (emphasis added).

Having reviewed the cited text of *Ackerman*, Applicant respectfully submits that the cited text of *Ackerman* does not teach or suggest "providing a software representation of a plurality of hardware components within said simulated direct access storage device". More specifically, the cited text of *Ackerman* discloses storing software within a physical DASD. Applicant respectfully submits that storing software within a physical DASD does not teach or suggest "providing a software representation of a plurality of hardware components within said simulated direct access storage device".

(B) Insufficient motivation is provided to combine the references to obtain Applicant's claimed invention.

With respect to exemplary Claim 1, Applicant respectfully submits that the Examiner's proposed combination of *Yu* and *Ackerman* does not render obvious Applicant's invention because the proposed combination of *Yu* and *Ackerman* lacks sufficient evidence of motivation or suggestion to combine the references, which motivation or suggestion is a necessary prerequisite for the proposed combination to render Applicant's invention obvious. M.P.E.P. § 2143. In evaluating motivation or suggestion to combine reference teachings, "a prior art reference must be considered in its entirety, *i.e.*, as a whole" (emphasis in original). M.P.E.P. § 2141.02, citing *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983) *cert. denied*, 469 U.S. 851 (1984).

When taken as a whole, *Yu* discloses a simulator particularly suited for simulating the hardware/software behavior of embedded systems (*Yu*, abstract), while *Ackerman* discloses an interactive system combining software simulators and hardware accelerators (*Ackerman*, abstract). In view of the teachings of the references as taken as a whole, it is apparent that there is no objective suggestion or motivation in the cited references (or generally in the art) that would lead a skilled artisan to combine *the reference teachings* to obtain *the present invention*. It is incumbent upon the Examiner to show, not merely that the combination of the references is advantageous, but that the combination would result in the recited features of Applicant's claim. MPEP 2142, citing *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. Appl & Inter. 1986). At paragraph 21, the Examiner merely asserts:

However, a direct-access storage device is a well known component in a digital hardware system such as the direct acces storage 80 of Figure 2B disclosed by *Ackerman* [Col. 7 lines 36-47].

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to apply the behavior simulation for simulating a digital hardware system taught by *Yu* for simulated direct access storage device as taught by *Ackerman*. This modification would have been obvious and a person having ordinary skill in the art would have been motivated to do so because it would enhance the application of the *Yu* invention.

While the expectation of an advantage, such as general enhancement to *Yu* relied upon by the Examiner can in some cases provide motivation to combine references, such a motivation is not facially adequate where the references do not teach the combination of features recited in Applicant' claim, or even the features for which the references are cited. The cited passages of *Yu* and *Ackerman* do generally discuss testing and verification, but the cited passages would not lead one skilled in the art to combine *Yu* with *Ackerman* to obtain Applicant's invention, both because the cited passage of *Ackerman* does not itself suggest the combination, and because the cited passage does not teach or suggest the features recited in Applicant's claims. Because the Examiner's combination of references is not supported by any objective teaching in the references or art, Applicant believes that the examiner has failed to establish a *prima facie* case of obviousness.

CONCLUSION

Applicant has diligently responded to the Office Action by amending the claims to overcome the Examiner's objections and by responding to the rejection of the claims under 35 USC §103, Applicant respectfully requests reconsideration of the rejection and issuance of a Notice of Allowance for all claims now pending.

Applicant further respectfully requests the Examiner contact the undersigned attorney of record at 512.343.6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,



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